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page 5, lines 10-11 of the application. As the examiner knows, the claims should be read with reference to the description, and therefore applicant did not think that it was necessary to add a feature that was inherent, as those skilled in the art would know of this inherent feature. The examiners comments state that she may overlook the term "extruded" because it is a process limitation in an apparatus claim. However, it is respectfully submitted that the term "extruded" as used in the claim is an adjective which not only describes the process by which the tube is made, but also describes inherent characteristics of the tube, namely that it has uniform inside and outside diameters. As this feature is clearly not shown in the examiners primary reference to Treptow, the allowance of all claim is respectfully requested.

It is again argued that the present apparatus is designed for the delivery of precise quantities of samples, and that Treptow is not designed for this purpose. Thus, it is the object of Treptow "...to provide a system for pipetting and photometrically evaluating samples which is more suitable for those analyses, for which the pipette tips are used one time only and are thrown away then."

The examiner states:

"In response to Applicants' argument that Treptow does not allow for securing a measured amount of sample, Treptow teaches at col. 2, lines 39-43 that the pipette allows samples and possibly reagents to be exactly dosed into quantities."

The exact phrase relied upon by the examiner is as follows:

"This system allows samples and, possibly, reagents to be exactly dosed into quantities being suitable for the photometrical evaluation, to be mixed and, immediately thereafter, to be photometrically evaluated with the aid of the same means."

At no place in the text of the patent, other than the phrase relied upon by the examiner, is there any teaching or suggestion of securing a measured amount of sample. The phrase that

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the examiner relied upon is subject to varying interpretations, and it is applicant's position that the device of Treptow does not teach taking samples in an accurate manner. The purpose of Treptow is to provide an apparatus for the photometric evaluation of samples. See col. 2, lines 11-15, quoted above. The phrase relied upon by the examiner should be compared with col. 3, lines 36-42, which talks about absorption of a liquid to be tested and then mixing. More specifically, it is stated that a coded pipette tip may have a reagent, and that after the pipette tip has been picked up from a tip container or magazine:

"A prompt facility [within the apparatus] can instruct the user by means of the display what to do next, e.g. the absorption of the liquid to be tested. Sample and reagent can be mixed in different ways, e.g. by up and down pumping of the liquid, the inner shape of the pipette tip or by the rotation thereof. The evaluation can be made automatically after sampling or mixture with the reagent."

Obviously, if the reagent is to be mixed with the sample by an up and down pumping of the liquid, there is no intent to take a sample in an accurate manner. It is clear that when this additional material is considered, along with the rest of the patent, that Treptow is not concerned with delivering precise quantities. Therefore, it is applicant's continued position that Treptow does not teach the subject matter of his application.

In the examiner's rejection of claims 4-5 she relies upon three reference. Initially, it should be noted that the primary reference to Treptow is defective for the reasons advanced above. Furthermore there is simply no teaching for the combination of references relied upon by the examiner, other than the teachings of this application. Thus there is no reason for combining d'Autry with Treptow in the manner suggested by the examiner, other than as hindsight reliance upon the teachings of this application.

The U. S. Supreme Court has stated in *Graham v. John Deere Co.* 148 U.S.P.Q. 459 the following:

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined."

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The Court of Appeals for the Federal Circuit [hereinafter C.A.F.C.] reiterated the factual determinations of Graham in *Greenwood v. Hattori Seiko Co.*, 14 USPQ 2d 1474 (1990). The Court of Custom and Patent Appeals has held in *In re Lunsford* 148 U.S.P.Q. 716 that the court must first look to the differences between the prior art and the subject matter sought to be patented and then determine if what the applicant did or made, *as a whole*, would have been obvious. The C.A.F.C. and other courts have consistently followed this "*as a whole*" approach for a number of years. Thus, the claims as a whole must be examined, and it should not be dissected when considering whether or not the whole claim was obvious. The C.A.F.C. has held in *In re Mills*, 16 USPQ 2d (1990) that while a reference disclosing an apparatus could have been modified to operate like the claimed apparatus, there must be a suggestion or motivation in the reference to do so in order to render the claimed invention obvious. In an earlier decision, *ACS Hospital Systems, Inc. v Montefiore Hospital* 221 U.S.P.Q. 929, 933, the C.A.F.C. held that:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so."

In the above case the C.A.F.C. held that the claimed invention was patentable because "The prior art of record fails to provide any such suggestion or incentive."

Furthermore, the examiner's attention is directed to MPEP §§ 2141-3 which sets forth the criteria of a non-obvious rejection. The examiner's attention is particularly directed to MPEP 2143.01 which states:

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combi-

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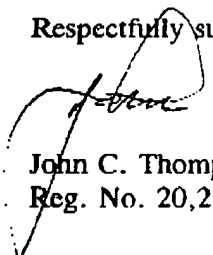
nation, or other modification." *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972).

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992)."

Clearly Treptow would not want a wire piston extending through his disposable pipette, as he would not be able to photometrically evaluate this samples. Not would there be any logical reason to substitute the structure of d'Autry for the piston of Treptow, other than to meet the terms of the claims. In that it would not have been obvious to one having ordinary skill in the art to modify Treptow by Holt et al and d'Autry in the manner that the examiner proposes, the examiner is respectfully requested to withdraw this grounds of rejection.

In that all claims of this application are deemed to be allowable for the reasons set forth above, the allowance of this application is respectfully requested.

Respectfully submitted,



John C. Thompson
Reg. No. 20,253

69 Grayton Road
Tonawanda, NY 14150

(716) 832-9447 (or 386 736 04780 from March 5 through March 25)
Facsimile: (716) 832-9392

enclosure:

Version with markings to show changes made

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

Claim 1 and 4 have been amended as follows:

1. (Amended) A pipette assembly having a small volume disposable tip capable of taking very small quantities of samples in an accurate manner, the pipette assembly being of an inexpensive construction, the pipette assembly comprising:

a suction device having a female tip receiver for receiving disposable pipette tips; and
a disposable pipette tip formed of extruded plastic tubing which has relatively uniform inside and outside diameters, the tubing being snugly received in the female tip receiver of the suction device.

4. (Amended) A pipette assembly having a small volume disposable tip capable of taking very small quantities of samples in an accurate manner, the pipette assembly being of an inexpensive construction, the pipette assembly comprising:

a suction device having

a piston cylinder in the form of a narrow tube having a distal end,
a piston slidable within the piston cylinder, the piston being in the form of a thin wire having a distal end,

means to move the piston between extended and retracted positions, the distal end of the piston being adjacent the distal end of the piston cylinder when in the extended position whereby there is substantially no air within the piston cylinder when the piston is extended, and

a female tip receiver for receiving disposable pipette tips, the female tip received being carried adjacent the distal end of the piston cylinder; and
a disposable pipette tip formed of extruded plastic tubing which has relatively uniform inside and outside diameters, the tubing being snugly received in the female tip receiver of the suction device, with one end adjacent the piston cylinder.